

### **REMARKS**

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-17 were in the application, claims 1-13 have been cancelled with claims 18-28 substituted therefore, and claims 14-17 were previously withdrawn.

The Examiner is advised that rejoinder may be considered in situations other than in species restrictions. MPEP 821.04(b) describes the rejoinder of process claims when product claims are found allowable, provided the withdrawn process claims either depend from or are amended to otherwise contain the limitations of an allowable product claim. That situation may arise in this application.

Claims 1-13 were rejected under 35 USC 112, second paragraph for various grammatical deficiencies. Claims 1-13 have been cancelled, rendering moot the rejection. However, new claims 18-28 have been substituted for claims 1-13, with claim 18 further presented as substantially a combination of the limitations of claims 1, 2 and 3. All of the claims were further amended for clarity and to better conform to U.S. claim format requirements. In preparing new claims 18-28, attention has been specifically given to correcting the deficiencies identified by the examiner, and new claims 18-28 are believed to be in compliance with 35 USC 112, second paragraph.

Claims 1, 3 and 8 were rejected as being anticipated by U.S. Patent no. 6,134,866. By the cancellation of these claims, and the presentation of new claim 18 as substantially a combination of limitations including those of claims 1, 2 and 3, this rejection has been rendered moot.

Claims 1-13 were rejected as being obvious over Monti, U. S. Patent 6,675,555 in view of Young, U.S. Patent 5,912,184.

To establish a prima facie case of obviousness based on a combination of references, there should be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In re Raynes, 7 F.3d 1037, 1039, 28 U.S.P.Q.2D (BNA) 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D (BNA) 1443, 1445 (Fed. Cir. 1992). However, the search for a

teaching or suggestion should not be rigid, and a more flexible approach to a determination of obviousness should be used so as to avoid a conflict with common sense. KSR International Co. v. Teleflex Inc. et al, 2007 U.S. Lexis 4745 U.S. Supreme Court, April 30, 2007. In this decision, however, the Supreme Court reaffirmed that obviousness can not be established by a hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

As the examiner recognized, Monti does not disclose a pressurized chamber, the Examiner believing that simply combining the pressurized chamber of Young with the packaging machine of Monti arrives at the present invention. However, this is incorrect, as two chambers are required according to the applicants' invention, and each surrounds different portions of the packaging machine such that some portions are in a pressurized chamber and others are not.

More is thus required for one skilled in the art, looking at the cited references, to arrive at the invention of applicants' claim 18, as one skilled in the art would find nothing to lead him to the two chambers of the applicants' invention, arranged over different portions of the packaging machine, and each at different pressures. According to the applicants invention, air flows into the first enclosure, which is maintained at a pressure above the outside pressure, some air exiting to the outside through passages, while other air enters the second chamber, which is maintained at a constant pressure equal to the outside pressure by suction means.

There is no teaching, suggestion or inference for the particular arrangement of elements, as are found in applicants' claim 18, and claim 18 and the claims depending therefrom are not believed to be obvious over the proposed combination.

The Patent and Trademark Office has the burden under section 103 to establish a prima facie case of obviousness. In re Piasecki 223 USPQ 2d 785 (Fed. Cir. 1984). They can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to an ordinary skill in the art would lead the individual to

combine relevant teachings of the references. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988).

There is no teaching or suggestion supporting the combination proposed by the examiner, and even if made, the proposed combination does not teach or suggest doing as the applicant has done. Rather, the examiner has made a hindsight reconstruction. Consequently, all the claims are believed to be unobvious over the cited art, as none of the prior art documents cited by Examiner describe, disclose or give any hints or suggestion, to provide the two enclosing chambers as defined in claim 18 of the applicants' invention.

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

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